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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/629,853

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Kiyoshi Kohiyama

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EXAMINER

PERUNGAVOOR, VENKATANARAY

ART UNIT

PAPER NUMBER

2432

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/629,853	<b>Applicant(s)</b> KOHYAMA ET AL.	
	<b>Examiner</b> Venkat Perungavoor	<b>Art Unit</b> 2432	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-24 and 26-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-24,26-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments, see pages 8-11, filed 3/4/2010, with respect to the rejection(s) of claim(s) 1-4,6-24,26-41 under 35 USC 102(b) as anticipated by NPL to NII(JP H10-333902) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of US Patent 5022077 to Bealkowski & US Patent 5987557 to Ebrahim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-24, and 26-41 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5987557 to Ebrahim.

Regarding Claim 1, Ebrahim discloses a hardware secure module having a tamper resistant module structure and storing information related to secure software see Fig. 1 item 112;

a memory that stores the secure software see Fig. 1 item 104;

a falsification checking unit that is loaded on the hardware secure module, wherein the falsification checking unit reads the secure software from the memory by direct access

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without using an operating system, compares the secure software with the information in the hardware secure module, and checks whether the secure software is falsified based on a result of the comparison see Col 3 Ln 29-45; and

a processor that executes the secure software when a result of the check by the falsification checking unit is that the secure software is not falsified see Col 7 Ln 2-16.

Regarding Claim 2-4, 6, 22-24, 26, Ebrahim discloses the second information being read in parts from each hard drive and non-volatile memory and further of comparing of the information see Fig. 2 item 104 & 110, 108.

Regarding Claim 7-12, 27-32, Ebrahim disclose the storing and updating of softwares see Col 8 Ln 6-29.

Regarding Claim 19, 39, Ebrahim discloses the MPEG configuration see Col 12 Ln 42-55.

Regarding Claim 20, Ebrahim discloses an information reproducing method comprising: reading secure software stored in a memory using direct access method without using an operating system, by a hardware secure module having a tamper resistant module structure which stores information related to the secure software see Col 3 Ln 29-45

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checking falsification by comparing the secure software with the information, and determining whether the secure software is falsified based on a result of the comparison Col 7 Ln 2-16 and

executing the secure software when a result of determining is that the secure software is not falsified see Col 7 Ln 2-16.

Regarding Claim 21, Ebhrahim discloses a hardware secure module mounted to an information reproducing apparatus and having a tamper resistant module structure, comprising:

a reading unit that reads a secure software from a memory mounted to the information reproducing apparatus by direct access without using an operating system see Col 3 Ln 29-45;

and a falsification checking unit that compares the secure software with information related to the secure software stored in the hardware secure module, and checks a falsification of the secure software based on a result of the comparison, wherein if the result of the comparison shows that the secure software is not falsified the secure software is executed by the information reproducing apparatus see Col 7 Ln 2-16.

Regarding Claim 40-41, Ebhrahim discloses the reading secure software stored in a memory using a direct access method and without using an operating system, by the hardware secure module having a tamper resistant module structure storing information related to the secure software see Fig. 1 & 2;

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checking falsification by comparing the secure software with the first information, and determining a falsification of the secure software based on a result of the comparison see Col 3 Ln 29-45; and

executing the secure software when the result of the comparison is that the secure software is not falsified see Col 7 Ln 2-16.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-18, 33-38, 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5987557 to Ebrahim in view of US Patent 5022077 to Bealkowski et al.(Bealkowski).

Regarding Claim 13-18, 33-38, 41, Ebrahim does not disclose the keys and encrypting of data. However, Bealkowski disclose the keys and secret information being used to store and encrypt the data see Col 12 Ln 36-48. It would be obvious to one having ordinary skill in the art at the time of the invention to include the keys and secret information being encrypted in the invention of Ebrahim in order to allow authorized system to boot-up BIOS image as taught in Bealkowski see Col Ln 30-56.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Venkat Perungavoor whose telephone number is (571)272-7213. The examiner can normally be reached on 8:00-4:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/V. P./  
Examiner, Art Unit 2432

/Gilberto Barron Jr./  
Supervisory Patent Examiner, Art Unit 2432